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Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gary J. Pond

Docket No. 4285.18554

Serial No.: 10/820,931

Examiner: Melba N. Bumgarner

Filed: 8 April 2004

Group Art Unit: 3732

Title: Irrigation Tip Adaptor for Ultrasonic Handpiece

REPLY BRIEF TO EXAMINER'S ANSWER

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

In response to the Examiner's Answer dated 6 February 2008, Applicant replies as follows:



I. THE OBJECTION TO CLAIM 9 UNDER 37 CFR 1.75 IS AN APPEALABLE MATTER

The Examiner's objection to claim 9 is an appealable matter properly put forth in the present appeal. As stated in the MPEP, "Where the differences of opinion concern the denial of patent claims because of ... patentability issues, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute (35 U.S.C. 134)." MPEP §1201. The issue with respect to claim 9 is an issue of patentability, as the Examiner is attempting to limit what the Applicant believes that he is entitled. Sections 1002.02(b)-(s) delineate the numerous matters that are petitionable. Matters under 37 CFR 1.75 are not listed in any of these sections, as 37 CFR 1.75 is directed towards patentability and, therefore, not a petitionable matter. There is nothing in 37 CFR 1.181 that suggests that matters under 37 CFR 1.75 are not appealable, either. Applicant's argument towards the objection under 37 CFR 1.75 remains in the appeal brief, unless it can be specifically noted where such matters under 37 CFR 1.75 are petitionable and not appealable.

II. CLAIMS 1-5 AND 9 MEET THE WRITTEN DESCRIPTION REQUIREMENT OF 35 U.S.C. § 112 ¶ 1.

The Examiner has maintained the rejection under 35 U.S.C. §112 ¶ 1, but has not put forth any reason why the application would not support the phrase "unitary, one-piece construction." Applicant previously noted Figures 4 and 7-11 show the body being of unitary, one-piece construction, and the specification does not suggest an interpretation that the adaptor should be anything but unitary one-piece construction. One having ordinary skill in the art would understand the adaptor as being such. The Examiner has not stated any reason why a person would draw a different inference. As the Federal Circuit has held, the drawings alone can be enough to support the written description requirement. In *Vas-Cath Inc., et al. v. Mahurkar et al.*, 935 F.2d 1555 (Fed. Cir. 1991), the written description requirement was met with an application's drawings, as the application did not include a written specification. As stated in section 2163 of the MPEP, "an applicant may show possession of an invention by disclosure of drawings ... that are sufficiently detailed to show that applicant was in possession of the claimed invention as a whole." (citing *Vas-Cath*, 935 F.2d at 1565). As in *Vas-Cath*, the drawings in the present application provide ample support so that one having reasonable skill in the art would believe that the Applicant had an

adaptor having a body of unitary, one-piece construction in his possession at the time the application was filed. As such, claims 1-5 and 9 meet the written description requirement of 35 U.S.C. § 112 ¶ 1.

III. CLAIMS 1-5 AND 9 ARE NOT INDEFINITE UNDER 35 U.S.C. § 112 ¶ 2.

The Examiner has maintained the rejection of Claims 1-5 under 35 U.S.C. § 112 ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as his invention. As previously asserted by the Applicant, the claims are directed only to the adaptor and are definitely recited as such. When reading the preamble in the context of the claim, the preamble is used to establish the relationship between the adaptor, the handpiece, and the tip. As noted in section 2111.02 of the MPEP, it is necessary to recite language of the preamble again in the body of the claim to distinctly claim the adaptor and also to note the proper spatial relationship and arrangement of the adaptor with respect to the handpiece and the dental tip. The body of the claims does not positively recite the handpiece or the irrigation tip. The preamble recites the handpiece, which is referred to in the body and not claimed in the body. The preamble recites the irrigation tip, which is referred to in the body and not claimed in the body. The Examiner's suggestion that the claims should be inferred to as including the irrigation tip and handpiece has no foundation in either 35 U.S.C. § 112 or the general rules of claim construction, as the Applicant has explicitly delineated in the claims, and further clarified the subject matter through comments in the various Office Action responses and the appeal brief, what he believes his invention to be. As such, the claims, as written, apprise "one having ordinary skill in the art of [their] scope and, therefore, serve the notice function required by 35 U.S.C. § 112 ¶ 2." See MPEP § 2173.02. The rejection of claims 1-5 and 9 under 35 U.S.C. § 112 ¶ 2 should be withdrawn.

IV. CLAIMS 1, 3-5, AND 9 ARE PATENTABLE UNDER 35 U.S.C. § 102(b) OVER FEINE, US. PAT. NO. 6,164,968.

The Examiner has maintained the rejection of claims 1, 3-5 and 9 under 35 U.S.C. § 102(b) as being unpatentable over Feine, U.S. Pat. No. 6,164,968. The Examiner's rejection is based on a "belief" that Feine shows a body having "unitary, one-piece" construction, a belief that is not shared by the disclosure in Feine. As pointed out by the Examiner, Figure 8 shows the adaptor of Feine, which does not show a "unitary, one-piece" adaptor. Figure 8 (reproduced below) shows a multiple piece ultrasonic insert, which is connected to a handpiece 70 (Reference numeral 12 is not a

handpiece, as suggested by the Examiner). Reference numerals 12 and 14 are definitely not of one-piece construction. The Examiner has not addressed this point, but rather has only decided to "pick and choose" from a single reference to the exclusion of other parts necessary for a full appreciation of what the prior art suggests. *W.L. Gore & Assoc., Inc.*, 721 F.2d 1450 (Fed. Cir. 1983). Feine shows and teaches an ultrasonic insert having multiple parts. The Examiner has decided that reference numeral 14, alone, constitutes the adaptor, while ignoring reference numeral 12, which is a necessity for Feine to properly function and operate.

The Examiner refers to Figure 4 of Feine to suggest again that Feine shows an adaptor having unitary one-piece construction, not including the O-rings. Figure 4 is shown below. Figure 4 definitively shows reference numeral 14 is not the same piece as the inner section (which is reference numeral 12, as indicated by Figure 8 of Feine), which means that the adaptor of Feine is not of unitary-one piece construction. The Examiner has also noted that Figure 4 also includes O-rings located between reference numerals 12 and 14, which would only be used if reference numerals 12 and 14 were separate sections and not a unitary piece. Feine does not disclose a unitary, one-piece construction adaptor for directly connecting a dental tip to a handpiece, which is required in each of claims 1, 3-5 and 9. Feine does not anticipate claims 1, 3-5 and 9.

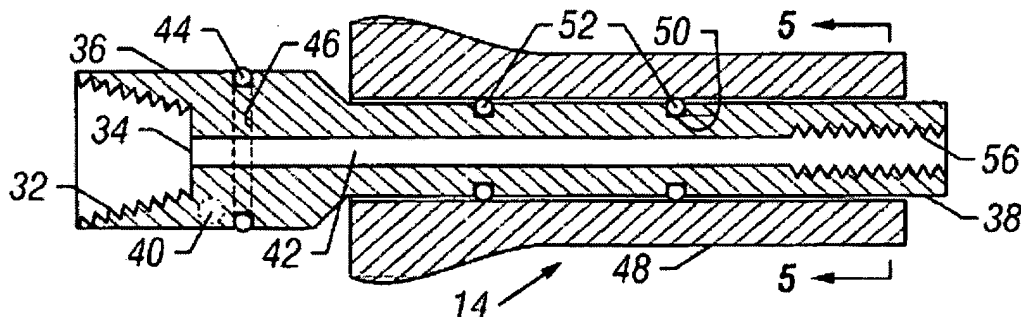


FIG. 4

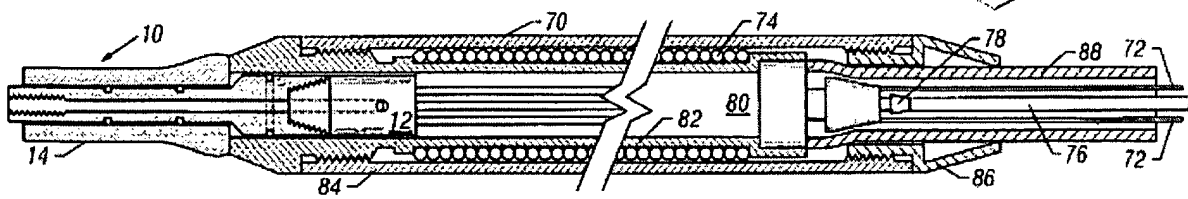


FIG. 8

V. **CLAIM 2 IS PATENTABLE UNDER 35 U.S.C § 103(a) OVER FEINE, US. PAT. NO. 6,164,968 IN VIEW OF SHARP ET AL., U.S. PAT. NO. 6,086,369.**

The Examiner has maintained the rejection of claim 2 under 35 U.S.C § 103(a) as being unpatentable over Feine, U.S. Pat. No. 6,164,968 in view of Sharp, et al., U.S. Pat. No. 6,086,369 (Sharp). As stated above, Feine does not disclose a dental adaptor being of unitary, one-piece construction, as the Examiner's omission of key elements of the Feine adaptor render the Feine adaptor inoperable for its desired purposed. Feine requires the separate pieces, reference numeral 12 and reference numeral 14, for the disclosed ultrasonic insert, and Feine does not meet the required limitations of an adaptor having unitary, one-piece construction. Neither does Sharp, which discloses a two-piece device (a connecting body 18 and a sleeve 22), as shown in Figure 2, and there is no suggestion or teaching in either Feine or Sharp as to how the combination of the two would result in the unitary one-piece adaptor of claim 2 that further restricts ultrasonic vibration to the tip. The Examiner has put forth no reason or argument as to why Feine and Sharp should be combined or could be combined to arrive at the invention of claim 2. Feine in view of Sharp does not obviate claim 2.

Conclusion

Applicant maintains the argument with respect to 37 CFR 1.75, as this is not a petitionable matter but an appealable matter related to what the Applicant considers as his invention.

Applicant has noted the Examiner's comments with respect to claim 1 and with reference to the proper serial number.

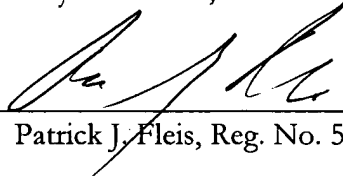
The Examiner seeks to deny patentability on the prior art teachings of Feine and Sharp, et al. Neither of these patents discloses an adaptor being of unitary, one-piece construction, which is a recited element of each of the pending claims. The combination of Feine and Sharp, et al., also does not provide for the claimed construction.

Feine does not anticipate claims 1, 3-5 and 9, and the combination of Feine and Sharp, et al. does not obviate claim 2.

Applicant has noted the support in the specification for the claims as they stand and has further addressed the objections put forth by the Examiner.

Respectfully Submitted,

By



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7 April 2008

Inter-Med/18554/080407 Reply Brief to Examiner's Answer

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By: *Julie A. Wolf*
Julie A. Wolf

Dated: 7 April 2008